United States Court of Appeals

for the Second Circuit

APPELLEE'S BRIEF

74-2540

To be argued by
RICHARD H. WELS

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ORIGINAL

In The

United States Court of Appeals

For The Second Circuit

ABERCROMBIE & FITCH COMPANY,

Plaintiff-Appellant,

vs.

P/S

HUNTING WORLD, INCORPORATED,

Defendant-Appellee.

On Appeal from the United States District Court for the Southern District of New York

Civil Action No. 70 Civ. 377, Ryan, J.

BRIEF FOR DEFENDANT-APPELLEE

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STATEMENT OF THE ISSUES

The issues presented on this appeal are:

1. Did the District Court properly find that the word "safari" is an ordinary, common, descriptive, geographic and generic word?

2. Did the District Court properly hold that there is no validity to a trademark of a descriptive word in the absence of registrant having established a secondary meaning?

3. Did the District Court properly find that the evidence established a complete absence of secondary meaning to "safari" by registrant?

4. Did the District Court properly find that plaintiff used "safari" in a descriptive, and not in a fanciful sense?

5. Did the District Court properly find that plaintiff's use of the word "safari" has not been a proper one, and that plaintiff accordingly has lost such trademark rights in "safari" as it ever had?

6. Did the District Court properly direct that plaintiff's trademark registrations of "safari" be cancelled?

7. Did the District Court properly find that defendant's use of "safari" has been a fair use in good faith to describe its goods and services and their geographical origin?

STATEMENT OF THE CASE

This is an appeal by plaintiff from a final judgment of the United States District Court for the Southern District of New York in favor of the defendant, entered after trial on October 15, 1974, on its counterclaim, dismissing the complaint on the merits and cancelling plaintiff's trademark "Safari" (A70, 71). Plaintiff has also appealed from the order of the District Court denying its motion for reconsideration of that part of the judgment cancelling plaintiff's trademark "Safari" (A69). The decision of the District Court (Judge Sylvester J. Ryan) is reproduced at pages A61 through A68 of the Appendix.

Plaintiff, having registered the word "Safari" as a trademark under the Lanham Act, as well as with the Secretary of State of the State of New York under the General Business Law of that State, brought this action to restrain the defendant from the continued use of the word "Safari" in its business (A3-9).

In its answer, the defendant alleged that the word "Safari" is an ordinary, common, descriptive, geographic and generic word in the Swahili and Arabic languages which, since prior to 1892, has been adopted into the English language, and is commonly used and understood by the public to mean and refer to a journey or expedition, especially for hunting or exploring in East Africa, and to the hunters, guides, men, animals and equipment forming such an expedition, and that it was not subject to exclusive appropriation as a trademark, whether under the Lanham Act or under the General Business Law of New York (A10-12).

The answer further alleged that since 1960 the defendant had used the word "Safari," whether alone or in connection with other words such as "Safari Shoes from Safariland," "Safari Chukka," "Hippo Safari," "The White Hunter—The Hat For Safari," "Minisafari," "Safari Clothes," "Safarigrade Zebra Rugs," "On Safari," "Safari Today," and "Safariland News" in good faith as a descriptive term and only to describe to users the goods or services furnished by defendant, or their geographical origin (A14).

After the joinder of issue, defendant moved for summary judgment upon the ground that there was no genuine issue of fact and that defendant was entitled to judgment as a matter of law. Subsequent to the making of such motion, but before it came on to be heard, plaintiff took the deposition of Robert M. Lee, the president and controlling stockholder of the defendant (A344-443). Defendant's motion for summary judgment was granted in part by Judge Morris Lasker, whose decision is reported at 327 F. Supp. 657 and 171 U.S.P.Q. 92, and is reproduced at pages A21-43 of the Appendix.

In his decision Judge Lasker held that, despite the trademarks registered by plaintiff, defendant was entitled to use the word "Safari" to describe those of its products which relate to the practice or cult of safari (A38). Judge Lasker found that defendant uses the word "Safari" descriptively rather than as a trademark (A34). He found that defendant's use of the word "Safari" in connection with its hats did not infringe the plaintiff's trademarks (A35-37). He further found that the use of the word "Safariland" for a boutique selling safari items, and the name of a corporate affiliate of defendant through which its

wholesale operations are conducted, did not constitute an infringement (A37-38).

Judge Lasker found that the use of the word "safari" by both parties in the sale of shoes was in a fanciful rather than a purely descriptive sense, and that the question of possible infringement by such use was dependent upon the resolution of a genuine issue of fact as to whether plaintiff had created a secondary meaning in the word "safari" as applied to its shoes, which could only be resolved in further discovery or on trial (A32, 38-39).

Plaintiff then appealed to this Court from Judge Lasker's decision granting in part defendant's motion for summary judgment. A panel of this Court consisting of Judge Feinberg, Judge Timbers, and Judge Thomsen (of the United States District Court for the District of Maryland, sitting by designation) heard the appeal on February 15, 1972. On April 26, 1972, this Court (Judge Feinberg, dissenting) reversed Judge Lasker's order, holding, without passing upon any part of the merits of the case, that genuine issues of fact existed which made it improper to enter a summary judgment finally denying even in part the injunctive relief sought by plaintiff. Such decision and opinions of this Court are reported at 461 F.2d 1044, and are reproduced at pages A44-60 of the Appendix.

The case was tried on remand in the District Court before Judge Sylvester J. Ryan, without a jury. Judge Ryan's decision after trial, dated September 30, 1974, held that defendant is entitled to judgment on its counterclaim dismissing the complaint on the merits and to a decree cancelling plaintiff's

trademark "Safari" (A68), and on October 15, 1974, judgment was entered on such decision (A70).

Judge Ryan found that the evidence showed that the word "safari" in connection with wearing apparel is widely used by the general public and the people in the trade (A64). He found that the evidence established the complete absence of any secondary meaning in "safari" (A64). He said further:

> "In his opinion, Judge Lasker ruled that plaintiff's trademark was a 'weak' mark and, as such, was not entitled to strict enforcement unless it had obtained a secondary meaning from plaintiff's use.
>
> After hearing the evidence, I go further and do now find that the mark is invalid because it is merely descriptive and does not serve to distinguish plaintiff's goods as listed in the registration from anybody else's. *Bassett Co. v. Revlon, Inc.*, 354 F.2d 868 (C.A.2, 1966); *Feathercombs v. Solo Products Co.*, 306 F.2d 251 (C.A.2, 1962); *Safeway Stores v. Safeway Properties, Inc.*, 307 F.2d 495 (C.A.2, 1962). Besides widespread use by plaintiff on other products and in other senses to describe the source or type of its goods and services, and its inability to control its use by others, have caused it to lose any identification it might have had originally with plaintiff's goods (although there was no proof of this) and a total loss of rights in

it (15 U.S.C. 1064(c)(e), 1127; *DuPont Cellophane Co. v. Waxed Products Co.*, 85 F.2d 75 (C.A.2, 1936).

Under the statute, a descriptive name may be protected only if it has through use become identified with plaintiff as its producer, rather than with its products. 15 U.S.C. 1052(e)(f).

There has been absolutely no evidence of any confusion, any palming off or any injury to the public or to plaintiff from defendant's use of the name 'safari' in any of its uses. The evidence of a widespread use of the word by the public and the present competition belies identification with any particular person. The trial proof showed that plaintiff's competitors, far from attempting to benefit from plaintiff's name and reputation, were genuinely surprised that plaintiff had registered the name and had claimed trademark significance.

No claim of copying by defendant is made. On the contrary, defendant has its own mark 'Hunting World, Inc.' and asserts its own fame in the market. Moreover, the hats and shoes produced by plaintiff differed significantly from that produced by defendant. In absence of any confusion, there is no legal right in plaintiff to attempt to appropriate a mark. *Venetianaire Corp. of America v. A & P Import Co.*, 429 F2d

1079; *King-Seeley Thomas Co. v. Aladdin Industries, Inc.*, 321 F2d 577 (C.A.2, 1963).

I find and conclude that the mark is invalid, that it belongs in the public domain, and direct that its registration be cancelled. 15 U.S.C. 1119: *Feathercombs v. Solo, supra*" (A64-66).

STATEMENT OF FACTS

Robert M. Lee, the president and controlling stockholder of defendant, has for many years been an expert on safari. He is the author of a book "Safari Today — The Modern Safari Handbook," published by the Stackpole Company in 1959 and copyrighted by him which was based upon his years of experience in the operation of safaris, and which is considered to be authoritative. In 1959, he formed Lee Expeditions, Ltd., a company primarily engaged in arranging safaris and expeditions to Africa (A250-255). In connection with arranging for and booking persons on safari, Lee has published "Safariland News" since 1961 (A255-259), and has purchased safari clothing, safari equipment, safari hats, and safari shoes which are imported into the United States from Africa for re-sale to the public, including but not limited to persons going on safaris (A62-63, 259-271). Defendant, which was incorporated in 1965, owns and operates the retail store through which such articles are sold. Defendant accurately advertises his shoes as "Safari Shoes From Safari Country" and as "The Safari Chukka," and his hats as "The Hat For Safari," and the "Minisafari Hat." Defendant also sells real safari clothing, made in Africa primarily for safari use.

As the trial Court correctly stated, there has been absolutely no evidence of any confusion, or any palming off (A65), and plaintiff's "Safari" shoes and hats admittedly were not fit for a safari — the shoes looked like sneakers and the hat was a fishing hat (A63, 64).

Concededly, plaintiff has registered the word "safari" and on February 18, 1969 made demand upon defendant to discontinue the use of the word "Safari," claiming that such use by defendant infringed trademarks registered by plaintiff. To this defendant replied that plaintiff could not claim that it had appropriated the word "Safari" to its exclusive use so as to bar the defendant's use of it, and that defendant considered that it had every right to make use of the words "Safari" and "Safariland" in connection with the merchandising of safari equipment.

ARGUMENT

Point I

The District Court properly found that the word "safari" is an ordinary, common, descriptive, geographic and generic word.

Judge Ryan, the trial judge, in the decision on review here, found that

> "The word 'safari' is an ordinary, common, descriptive, geographic and generic word, which has been adopted into the English language, used and understood to refer to a journey or

> expedition, particularly to Africa, for hunting or exploration" (A63).

The same conclusion had earlier been reached by Judge Lasker in his earlier decision on the motion for summary judgment. In that decision he said:

> "The parties here agree that 'the word "safari" is a word found in Swahili and Arabic languages, which, since prior to 1892, has been adopted into the English language, and is commonly used and understood to mean and refer to a journey, or expedition, especially for hunting or exploring in East Africa, and to the hunters, guides, men, animals, and equipment forming such an expedition.' (Defendant's General Rule 9(g) Statement, paragraph 3; 'Admitted' in Plaintiff's Rule 9(g) Statement)" (A28-29).

Judge Lasker found "safari" to be a generic word (A32), and further said:

> "We start from the proposition, acknowledged by the parties, that the word 'safari' has entered widely into the common vocabulary of English-speaking peoples. Its general meaning is set forth above, and this meaning is substantially correct according to lexicographers. It is used in a variety of descriptive senses related to its basic meaning. Cf. the use of the word in *United States ex rel. Bennett v. Rundle,* 419 F.2d 599 (3rd Circ., 1969" (A30-31).

Judge Ryan found that

> "Moreover the evidence showed that the word 'safari' in connection with wearing apparel is widely used by the general public and the people in the trade" (A64).

Such finding was supported by the exhibits received as DX-A, DX-B, DX-C, DX-D, DX-E, DX-F, DX-G, DX-H, DX-I, DX-J, DX-L, DX-N, DX-O, DX-P, DX-Q, DX-R, DX-S, DX-S1, DX-T, DX-U, DX-W, DX-X, DX-Y, DX-Z, DX-AA, DX-CC, DX-NN, DX-III, and DX-LLL.

It has long been an established principle of trademark law that a common, ordinary, descriptive word may not be appropriated through the device of a trademark registration, and others thereby prevented from making use of it. See, by way of example, *King-Seeley Thermos Co. v. Aladdin Industries, Inc.*, 321 F.2d 577 (2d Cir. 1963); *King Seeley Thermos Co. v. Aladdin Industries, Inc.*, 418 F.2d 31, 35; *Homemakers Home and Health Services, Inc. v. Chicago Home For the Friendless*, 484 F.2d 625 (7th Cir. 1973); *Bada Company v. Montgomery Ward & Co.*, 426 F.2d 8 (9th Cir. 1970), *cert. den.*, 400 U.S. 916; *Donald F. Duncan Inc. v. Royal Toups Mfg. Co.*, 343 F.2d 655 (7th Cir. 1965); *Continental Insurance Co. v. Continental Fire Assn.*, 96 F. 846, 101 F. 255; *Selchow & Righter v. Wester Painting & Lithographing Co.*, 47 F. Supp. 322, 325, *aff'd.*, 142 F.2d 707 (7th Cir. 1944), *cert. den.*, 323 U.S. 735; *Henry Heide, Inc. v. George Ziegler Co.*, 354 F.2d 574 (7th Cir. 1965); *Dresser Industries, Inc. v. Herseus Engelhard Vacuum, Inc.*, 395 F.2d 457 (3d Cir. 1968), *cert. den.*, 393 U.S. 34; *Field Enterprises*

Educational Corporation v. Cove Industries, Inc., 297 F. Supp. 989 (E.D.N.Y. 1939); *B & L Sales Association v. H. Daroff & Sons, Inc.*, 298 F. Supp. 908 (S.D.N.Y. 1969); *Bowman Gum, Inc. v. Topps Chewing Gum, Inc.*, 103 F. Supp. 944 (E.D.N.Y. 1952); *Nissen Trampoline Co. v. American Trampoline Co.*, 193 F. Supp. 745 (S.D. Iowa 1961); *Caron Corp. v. Maison Jeurelle-Seventeen, Inc.*, 26 F. Supp. 560 (S.D.N.Y. 1938); *Colby College v. Colby College-New Hampshire*, 374 F. Supp. 62 N.E. 582, 1141 (D. N.H. 1974); *Cook & Cobb Co. v. Miller*, 169 N.Y. 475; *Wolf v. Burke*, 56 N.Y. 115; *Barrett Chemical Co. v. Stern*, 176 N.Y. 27, 68 N.E. 65.

The District Court correctly found that there is no validity to a trademark of a descriptive word in the absence of registrant having established a secondary meaning, and that the evidence showed a complete absence of secondary meaning to "safari."

In his decision, Judge Ryan pointed out that

> "Under the statute, a descriptive name may be protected only if it has through use become identified with plaintiff as its producer, rather than with its products. 15 U.S.C. 1052(e)(f)" (A65).

He also said:

> "Although there was evidence that plaintiff had attempted to police some of these uses by people

> in the trade, there continued to be widespread use of the word and plaintiff was unable to control it. Admitted ignorance on the part of these users of plaintiff's claimed trademark is eloquent proof of the weakness of the mark and established the complete absence of any secondary meaning in it.
>
> In his opinion, Judge Lasker ruled that plaintiff's trademark was a 'weak' mark and, as such, was not entitled to strict enforcement unless it had obtained secondary meaning from plaintiff's use.
>
> After hearing the evidence, I go further and do now find that the mark is invalid because it is merely descriptive and does not serve to distinguish plaintiff's goods as listed in the registration from anybody else's. *Bassett Co. v. Revlon, Inc.*, 354 F.2d 868 (CA.2, 1966); *Feathercombs v. Solo Products Co.*, 306 F.2d 251 (C.A.2, 1962); *Safeway Stores v. Safeway Properties, Inc.*, 307 F.2d 495 (C.A.2, 1962)" (A64-65).

The question of secondary meaning has run throughout this litigation. As to those aspects of the case concerning which he did not grant summary judgment to the defendant, Judge Lasker held that plaintiff was entitled to establish in the discovery process or on trial its contention that a secondary meaning has been created (A32, 38-39).

In its brief on appeal to this Court from Judge Lasker's decision, plaintiff urged that, as to those aspects concerning

which Judge Lasker had granted summary judgment against it, "plaintiff should have the right to prove secondary meaning at trial" and that "it was error for the District Court to grant any summary judgment which would preclude plaintiff from its right to prove secondary meaning, as to descriptive uses of Safari" (Plaintiff-Appellant's Brief, *Abercrombie & Fitch Co. v. Hunting World, Incorporated,* (Docket No. 71-1806, pp. 18 and 24). This Court agreed that plaintiff should have such right and opportunity, saying that

> "We intimate no opinion as to the ultimate merits of the case. But viewing the inferences to be drawn from the underlying facts in the light most favorable to the party opposing the motion for summary judgment, we conclude that genuine issues of fact exist which made it improper to enter a summary judgment finally denying even in part the injunctive relief sought by plaintiff" (A51).

A mark is said to have acquired secondary meaning when the public has come to identify a product or service bearing such mark as coming from a particular source or supplier. For a word or mark to have acquired a secondary meaning, the public consciousness must have been so affected that the word has lost its primary descriptive significance and changed so that, when members of the public see or hear the word, they identify it with a particular source.

Judge Learned Hand, in *Bayer Co. v. United Drug Co.,* 272 F. 505, 509 (S.D.N.Y. 1921), laid down the classic test of secondary meaning when he said:

> "The single question, as I view it, in all these cases, is merely one fact: What do the buyers understand by the word for whose use the parties are contending? If they understand by it only the kind of goods sold, then, I take it, it makes no difference whatever what efforts the plaintiff has made to make them understand more. He has failed and he cannot say that, when the defendant uses the word, he is taking away customers who wanted to deal with him, however closely disguised he may be able to keep his identity."

Plaintiff produced not a single customer, and not a single survey, in support of its claim of having achieved secondary meaning for Abercrombie & Fitch with safari. Its proof fell short of even what this Court found to be insufficient in *Hiram Walker & Sons v. Penn-Maryland Corp.*, 79 F.2d 836, 839 (2d Cir. 1935), where it said:

> "The claim that the public have come to associate the word 'Imperial' exclusively with its product is founded merely upon the assurance of officers of the appellee unsupported by any details. The affidavits of three bartenders and the proprietor of a liquor business that they always served Hiram Walker's Imperial when a customer sought 'Imperial' whiskey, fall far short of establishing that the association of ideas was the widespread, general custom necessary to establish even prima facie that 'Imperial' had acquired a secondary meaning."

Plaintiff's brief here argues as to this, at pages 9 and 10, that "Abercrombie's sales and advertising under the 'Safari' trademark have been substantial."

But, as has been pointed out in *Smith v. Chanel, Inc.*, 402 F.2d 562, 568 (9th Cir. 1968), this is not dispositive because a "large expenditure of money does not in itself create legally protectable rights." Rather, as was said in *Carter-Wallace, Inc. v. Proctor & Gamble Company*, 434 F.2d 794, 802 (9th Cir. 1970), the test of secondary meaning is the *effectiveness* of the effort to create it, and whether this effort has resulted in the identification of the mark in the public consciousness as a single thing coming from a single source. As was said in *Premier-Pabst Corp. v. Elm City Brewing Co.*, 9 F. Supp. 754, 760 (D. Conn. 1935)

> "The sums spent in advertising, its scope, nature, and duration, are all important factors, but not necessarily conclusive. After all, the issue is the achievement of an identity and not the effort expended in the attempted achievement. Nor is success in stimulating sales, necessarily decisive. For, conceivably, such sales may have resulted from methods of sales promotion having no tendency to create any specific association between the public and a particular producer."

Here plaintiff relied solely upon the testimony of its only witness, Henry C. Geis, its vice president and treasurer (A72-244). Mr. Geis testified that, it addition to newspaper and magazine advertising, plaintiff advertised its products through

catalogues which it mailed out to some 400,000 to 450,000 customers four times a year (A78-79).

Mr. Geis could not testify as to the amount of advertising and promotion for Safari clothing alone. He said "I wouldn't be able to do that. I just know what we spend overall for advertising" (A119). He testified that Safari merchandise represented only 10% of plaintiff's total clothing items, and that in addition plaintiff sold sport items, fishing rods, rifles, marine equipment, gifts and shotguns (A119). His testimony indicated that the volume of Safari labelled merchandise was in the neighborhood of $558,823 a year. He testified that in the thirty-four year period between 1936 and 1970 plaintiff's sales of Safari labelled merchandise aggregated approximating $19,000,000 (A117-118). This represents average annual sales of $558,823.

Mr. Geis testified that the four catalogues published each year account for about half of plaintiff's annual advertising expenses (A121). It was conceded that the catalogues are directed to all of plaintiff's merchandise, and not just to its Safari labelled merchandise (A121-122).

An examination of plaintiff's catalogues received in evidence demonstrated forcefully that plaintiff's catalogues devote an infinitesimal part of their space to Safari labelled merchandise (DX-KK, DX-OO, DX-PP, DX-RR, DX-SS, PX-32, PX-33, PX-34, PX-35, PX-36, PX-37, PX-280). Such examination explains the meager contribution of the manufacturers of plaintiff's Safari labelled merchandise (referred to by Mr. Geis as plaintiff's vendors) to plaintiff's advertising costs.

Mr. Geis testified that the great bulk of plaintiff's Safari labelled merchandise was manufactured not by plaintiff but by others for it, some being made to plaintiff's specifications and others not (A85-86).

Mr. Geis testified that plaintiff's vendors — the manufacturers of merchandise sold by plaintiff — contributed to advertising costs (A168-169). But those vendors who were the manufacturers of plaintiff's Safari labelled merchandise made contributions that were miniscule.

Thus, he testified that Willis & Geiger, from whom a great deal of plaintiff's Safari clothing is purchased, made no contribution whatever to such advertising expense (A228-229). He testified that the Safari Topsider Division of Uniroyal, which manufactures the Safari Oxford Shoe for plaintiff, contributed $500 a year to p. ntiff's advertising expense (A229). And he testified that Byer-Rolnick, which sells merchandise to plaintiff including Safari round hats, contributes between $1,200 and $1,500 a year to plaintiff's advertising expense, of which one-half is attributable to Safari labelled items (A229-230). Thus, of the $336,134 contributed by plaintiff's vendors to plaintiff's advertising expenses (A168-169, PX-47), a maximum of $1,250 was attributable to the vendors of Safari labelled merchandise. This is understandable in the light of the fact that mention of Safari merchandise represents a very minor part of the merchandise advertised in plaintiff's catalogues.

Thus, plaintiff's 1971 Christmas catalogue (DX-KK) — entitled "Abercrombie & Fitch is a Christmas Safari" — is an 84 page catalogue, which advertises approximately 433 articles of

merchandise. Of these, there are references to only eight safari items — on page 41, the "sensational safari; " on page 46, the "Safari sport shirt featuring two patch pockets;" at page 31, "the authentic safari bush jacket;" at page 59, "the Safari Grill;" at pages 70-71, an advertisement of Adventures Unlimited for safari trips; at page 77 Abercrombie's "exclusive Safari Sweaters;" at page 63 the "Safari Sleeping Bag;" and at page 66, "the Safari Series of Glasses."

Similarly, plaintiff's 1973 Spring/Summer catalogue (DX-OO) consists of 32 pages, and advertises approximately 239 articles of merchandise. It contains but 10 references to Safari labelled merchandise. On page 14, Item N is the "Bancroft Tretorn safari boot for comfort on the most rugged hikes. Suede in fawn or dark brown." On page 19, Item A reads "Who but Tannerway could come up with such a dashing 'today' look! The put-together safari costume is in polyester and cotton kettlecloth. Both parts in faded blue and sized 8-18. The short-sleeve, tie-belted safari jacket." And on page 29, Items D, E, I, J, K and M have references to the Safari sportcoat, Safari pants, Safari slacks, Safari creel vest, Safari cloth all-around hat, and Safari shorts.

Again, plaintiff's 1972 Christmas catalogue (DX-PP) consists of 68 pages, featuring approximately 519 items. Of these only eight relate to safari. On page 12 item A relates to a "Safari sport coat . . . by Gordon of Philadelphia for us alone." Item F is the "Exclusive safari kimono." Page 13 is captioned "Exclusive A & F Gifts Safari," listing no safari labelled merchandise but reading "Give her the complete safari this winter." On Page 9, Item D is the "Bass Weejuns Safari Boot." Item E on page 35 is "Our safari vest," and Item H on page 38 is

"Our safari folding stool." Page 54 is another advertisement of Adventures Unlimited for five safari trips captioned "How About Giving Africa This Year?" And Item C on page 63 is "The Brent Safari — our imported suede jacket with authentic safari styling. Satin body lining."

Another of plaintiff's 1972 catalogues (DX-RR) consists of 24 pages and advertises approximately 141 items. It advertises exactly three Safari items — On page 10 Item B is an "Alpaca lined safari jacket" and "100% cotton safari ranch pant." And on page 20, Item G is "Safari hunt pants."

Yet another of plaintiff's catalogues is entitled "The Blazed Trail 1973" (DX-SS). It consists of 52 pages and advertises approximately 366 articles of merchandise. Of these a total of 14 relate to safari. Item H on page 12 advertises "Our exclusive Safari cloth trousers." Item C on page 15 advertises a Safari cloth jacket, and Item D "A & F polyester safari hat." Item E on page 18 refers to both "Canvas-front hunting pants in cotton Safari cloth" and to Byer-Rolnick's Safari Canuck cap." On page 20 Item A related to the long-sleeved Safari cloth shirt, and Item D to "Our own Safari cloth sport jacket." Item C on page 42 carries the message that "Attractive route to the safari takes the skirt-plus-shirt approach. Safari cloth frontier skirt from our own workrooms" and Item D urges "Promise her a safari! And give it to her via deftly tailored Safari cloth." Page 44 presents "A striking group of safari prints," and on the same page, Item G is a "Safari swordfish cap."

Plaintiff's proof of such meager advertising and promotion in support of its safari merchandise cannot establish a claim of having established a secondary meaning as to safari.

In his opinion, Judge Ryan said:

> "Although there was evidence that plaintiff had attempted to police some of these uses by people in the trade, there continued to be widespread use of the word and plaintiff was unable to control it. Admitted ignorance on the part of these users of plaintiff's claimed trademark is eloquent proof of the weakness of the mark and establishes the complete absence of any secondary meaning to it" (A64).

The Court was referring to PX-39 and PX-40, PX-39 consisting of a file captioned "PLAINTIFF'S POLICING OF SAFARI AS TO CLOTHING, RESULTING IN ABATEMENT OF INFRINGEMENT, SHORT OF LITIGATION." PX-40 consisted of a series of letters from major retailers to plaintiff's counsel in which they said that they made use of the word "safari" in their advertising without any knowledge that such word had any identification with or relation to plaintiff. Such exhibits were offered and received (A122-134) in support of the claim that plaintiff had amply asserted its right to the exclusive use of the word Safari with relation to certain articles, and that the exclusive right had been acknowledged and recognized by others in the industry.

In the light of the statements from such sophisticated merchandisers and advertisers as Bonwit Teller, Macy's, Abraham & Straus, Altman's, Gimbel's, Saks Fifth Avenue, Henry Modell & Co., F. R. Tripler & Co., Wallach's, Sears Roebuck, and United States Shoe Corporation, among others

(PX-40), that they were completely unaware of any connection between plaintiff and the word "Safari." Judge Ryan's conclusion that there was a complete absence of any secondary meaning here (A64) was amply supported.

As was pointed out in *Saalfield Publishing Co. v. G. & C. Merriam, Co.*, 238 Fed. 1 (6th Cir. 1917), *cert. den.*, 243 U.S. 651:

> "Retailers are better and more reliable witnesses than indiviudal customers as to whether a word has acquired a secondary meaning so that members of the public who see or hear the word identify it with a particular source."

Point III

There is no merit to appellant's argument that its use of "Safari" was suggestive rather than descriptive, and that its trademark rights are valid even in the absence of secondary meaning.

Appellant has sought to carve out for itself an exception to the general rule that a descriptive mark can only be protected if it had acquired a secondary meaning so as to identify the product with the producer. In its brief it says that its use of "Safari" as a trademark does not immediately convey to the purchaser the character of the goods sold, and is not an accurate or a descriptive term with respect to goods sold by it, but is a suggestive mark, which carries with it a distinctive connotation and an appeal to the discriminating and elite customer.

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The record is very clear that Abercrombie has in fact used "Safari" in a descriptive sense.

Thus, in an advertisement published in the New York Times for May 23, 1973, by Abercrombie & Fitch, appellant said:

"COME ON! JOIN!
SAFARI WEEK AT ABERCROMBIE & FITCH

> We put the mark on the word 'Safari' because we own it. We outfitted such noted Safari-bound as Theodore Roosevelt and Ernest Hemingway. Now we're having a whole festive week of African dancing, African drama, African cooking and colorful movies. On our roof every day, 12-2:30, and throughout the store.
>
> Shown: Ladies' navy safari suit of corded 100% polyester . . ." (DX-LL).

In plaintiff's 1971 Christmas catalogue, captioned on the cover "ABERCROMBIE & FITCH IS A CHRISTMAS SAFARI" (DX-KK), the inside cover read:

> "There was a time — not too many years ago — when the only thing that people thought of when they encountered the word 'safari' was a big game hunt, led by an expert guide, under a broiling African sun. Very dramatic . . . very expensive . . . something very few people could hope to experience.

Those safaris still exist.

But now we have a new kind of safari — a much more pleasurable one.

It's the 1971 Abercrombie and Fitch Christmas Gift Safari. And it can take place right in the comfort of your own home — with this book as your expert guide. . . ."

And at page 71 of that same catalogue was its invitation to its "INVITATIONAL SAFARI," reading:

"Nor, since the Macombers has there been a posh safari like this. All the comforts and luxury you could want. 4-wheel drive land cruiser gets you to the game sanctuaries in splendid comfort. Zip-in tents, real beds, mattresses, electric lights, and daily laundry service make roughing it a mighty comfortable experience. Even fresh fruit and vegetables are flown in.

This Safari takes you away from the tourist circuit and includes such fascinating safari spots as Amboseli, Lake Manyara, Ngorongoro, Loliondo, Serengeti, Mara, Lake Naivasha, Hell's Gate, Lake Nakaru, Samburo-Isiolo, Meru and if you hunger for more after why not take an extension to Victoria Falls in Zambia and/or Murchison Falls in Uganda. . . ."

DX-KK

DX-KK

There was a time—not too many years ago—when the only thing that people thought of when they encountered the word "safari" was a big game hunt, led by an expert guide, under a broiling African sun. Very dramatic... very expensive... something very few people could hope to experience.

Those safaris still exist.

But now we have a new kind of safari—a much more pleasurable one.

It's the 1971 Abercrombie and Fitch Christmas Gift Safari. And it can take place right in the comfort of your own home—with this book as your expert guide.

Still a very dramatic hunt. And beautifully not very expensive. Something that many people will have the joy of experiencing.

And the prizes... a wealth of distinctive gifts for giving and getting. A rare collection of the very exciting new and the treasured old. All captured in the pages that follow.

We hope that you'll join in this 1971 A&F Christmas Gift Safari. We know that you will find it richly rewarding.

(opposite page)
All the glamour in the world wrapped up in this glorious sweeping warm coat. Plunging to the floor in a mist of very, very pale green, it's dramatically emboldened with white lamb fur. Softest shearling, magnificently styled, and tailored as only the English can. A most beautiful gift for the most important woman in your life. Sizes 6 to 14. 63-777 **400.00** (Exp.)

Due to government regulations, we cannot guarantee the prices of imported items in this catalog after it was printed.

Most prices in this catalog are slightly higher on the west coast.

On February 22, 1970, plaintiff published in the New York Times, Sunday edition, an advertisement (DX-HH), in which it advertised

> "Save 1/3 to 1/2 off the original prices on the world's most exclusive women's roughwear cloth — designed originally by us for African Safaris — into high fashion outdoor jackets."

On September 7, 1972, plaintiff published in the New York Times an advertisement (DX-DD) reading

> "ABERCROMBIE & FITCH
>
> the supreme safari
>
> . . . ours alone
>
> Malcolm Kenneth has created for us what has to be the most magnificent safari suit around. It is, of course, our authentic safari — impeccably crafted in a blend of finest cotton and Dacron polyester. . . ."

Another advertisement published in the New York Times (DX-FF) was for "city safari — urbane enough to step down Fifth Avenue — Willis & Geiger's impeccable white Dacron polyester/cotton safari suit." Another advertisement of plaintiff's (PX-69) was captioned "Take A Short Safari."

In its "Blazed Trail Catalogue" for 1973 (DX-SS) at page 42 plaintiff published the following:

DX-KK

INDULGENCE

INVITATIONAL SAFARI

Not since the Macombers has there been a posh safari like this. All the comfort and luxury you could want. 4-wheel drive land cruiser gets you to the game sanctuaries in splendid comfort. Zip-in tents, real beds, mattresses, electric lights, superb meals and daily laundry service, make roughing it a mighty comfortable experience. Even fresh fruit and vegetables are flown in.

$2350 per person*

This Safari takes you away from the tourist circuit and includes such fascinating safari spots as Amboseli, Lake Manyara, Ngorongoro, Loliondo, Serengeti, Mara, Lake Naivasha, Hell's Gate, Lake Nakaru, Samburo-Isiolo, Meru and if you hunger for more after why not take an extension to Victoria Falls in Zambia and/or Murchison Falls in Uganda.

21 days even the most jaundiced traveler will be awed by. Departure dates 1972: January 6, January 27, February 17, June 22, July 13, September 21, November 9.

THE ROCKRESORTS VACATION CHECK

A new and marvelously clever way to get someone to take that long over-due vacation. Simply give "him-her-them" a Rockresorts Vacation Check. It's good as gold in any one of these fabulous resorts: Little Dix Bay, British Virgin Islands; Mauna Kea Beach Hotel, Hawaii; Woodstock Inn, Woodstock, Vermont; Jackson Lake Lodge, Grand Teton National Park, Wyoming; Dorado Beach Hotel or Cerromar Beach Hotel, Dorado Beach, Puerto Rico; Caneel Bay Plantation, St. John, Virgin Islands.

$50 to $50,000

The Check is issued in any amount from $50.00 up. It can be used in payment for all hotel expenses. Accommodations, meals, greens fees and the like. There's no time limit.

HOWEVER,

Send us your personal check right now with the name and address of the lucky vacationer. We'll transform it into a super-gift Rockresorts Vacation Check.

Wait 'til you see your thank you note.

HEADQUARTERS SAFARI

A rare chance to combine big game spectaculars with deluxe hotel living for 22 incredible days. You unpack just once, keep your hotel room in Nairobi the entire time.

$2095 per person*

Some days you fly out to the bush in a private twin-engine plane. A 4-wheel drive land cruiser picks you up at the airstrip and takes you to the sanctuaries to watch and photograph. At sunset back you go to civilization and your luxurious hotel headquarters for air-conditioning, silky sheets, and cold martis.

Other times you'll spend nights away from Nairobi (but your room is kept there) at delicious remote places you don't usually have time for on an ordinary safari: Treetops, Mt. Kenya Safari Club, Lamu, Samburu, Lake Baringo, Tsavo, and Lake Manyara.

And, as an extra bonus, Headquarters Safari introduces you to the people of Africa. You visit local industry, Parliament, local schools and all efforts are made for you to meet your professional counterparts, one of the big reasons why this Safari is invariably a sell-out to the chic and knowledgeable. Departure dates 1972: January 24, March 13, June 19, July 10, September 25, October 30.

adventures unlimited

Located at Abercrombie & Fitch

19 East 45th Street, New York, New York 10017

220 Post Street, San Francisco, California 94108

*approximate land cost, air fare additional, plus applicable supplement for single room

"C. Attractive route to the safari, takes the skirt-plus-shirt approach. Safari cloth frontier skirt from our own workrooms. . . .

D. Promise her a safari! And give it to her via deftly tailored coordinates of putty colored Safari Cloth. . . .Frontier pants, also of Safari cloth."

In an advertising supplement published in the Sunday New York Times (DX-QQ) Abercrombie & Fitch published an advertisement with photographs of five individuals wearing nine items of appellant's safari clothes, with the introductory statement:

"Safari cloth — Made exclusively for Abercrombie & Fitch to keep people comfortable on safaris."

In another advertisement published by plaintiff in the New York Times (DX-GG) the caption reads:

"As worn on safari . . .

the 'Salty Dog.'

This is the safari suit worn by professional hunters in the African bush. Yet the quality of its tailoring puts it also at ease on city streets. . . ."

And in one of its 1972 catalogues (DX-PP), plaintiff at page 13 advertises its "Exclusive A & F gift safari . . . .Give her the

DX-HH

Save $7.50 on the world's most luxurious sport shirt —of pure Viyella. Plaids $21.50 now $14.00. Solids $17.50 now $11.00. Only at Abercrombie's — has extra long shirttails so they won't pull out when active. Selected group. 5th floor.

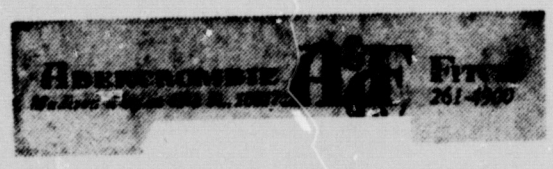
Save 1/3 to 1/2 off the original prices on the world's most exclusive women's roughwear cloth —designed originally by us for African Safaris— into high fashion outdoor jackets. Selected group. Second floor.

Save $33.00 on Limoges plates with the original artwork of the Federal Duck Stamp. The only plates of their kind in the world. A set of six with artwork from the original stamps. Were $98.00. Set of six, now $65.00

Save $10.00 on the world's most compact fishing rod — The vest pocket rod—packs into a box that you can slip into your vest pocket. The world's smallest, most compact rod — makes a perfectly balanced, professional fly rod. An exclusive invention of Abercrombie & Fitch. Was $32.50, now $22.50.

Save $4.51 on the world's finest men's slacks and shorts—the best wearing, best using slacks and shorts we have known. Made exclusively for us of cotton and Fortrel in maize or white. Were $14.50, now $9.99, Shorts were $10.50, now $8.99.

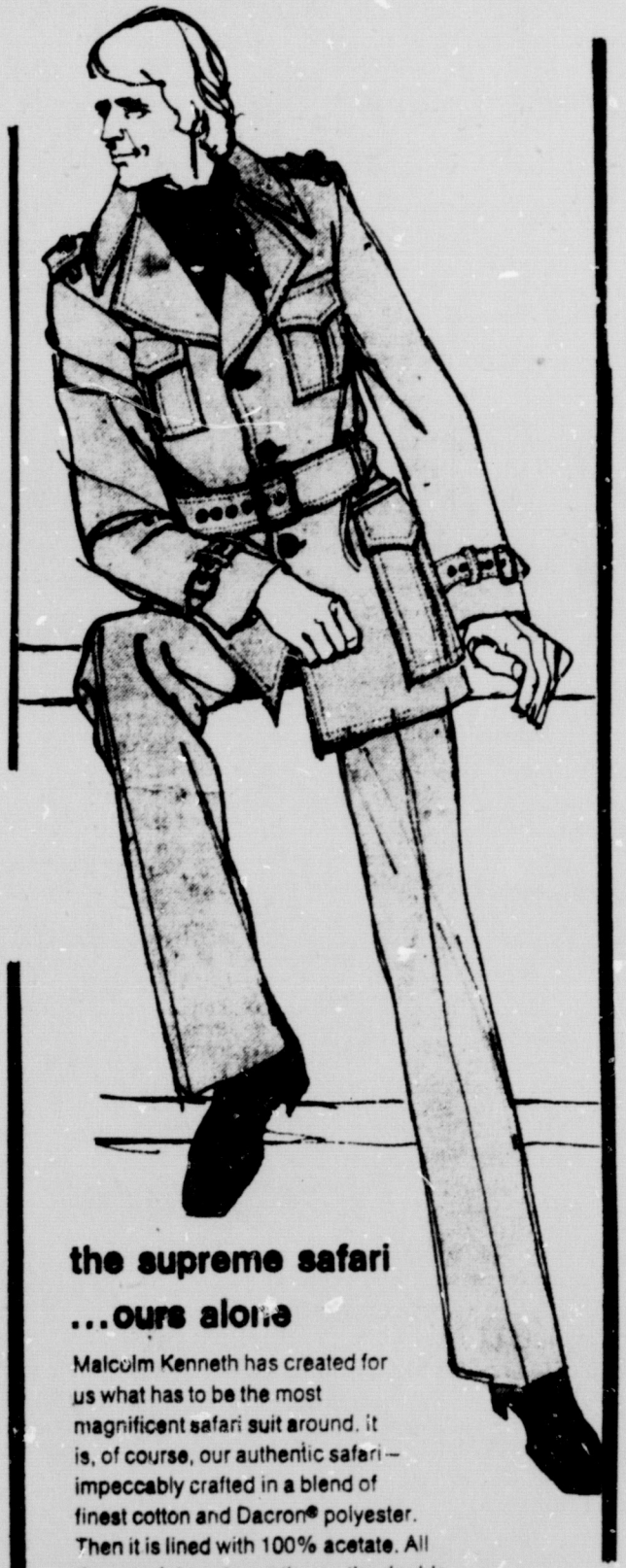
Save $30 to $55 on the world's finest suedes and leather jackets for men — beautifully softened in the tanning and fine tailored so they fit, as you would expect at Abercrombie & Fitch. Assorted styles and lengths. 25% off selected groupings.



ONLY COPY AVAILABLE

DX-DD

ABERCROMBIE & FITCH



the supreme safari ...ours alone

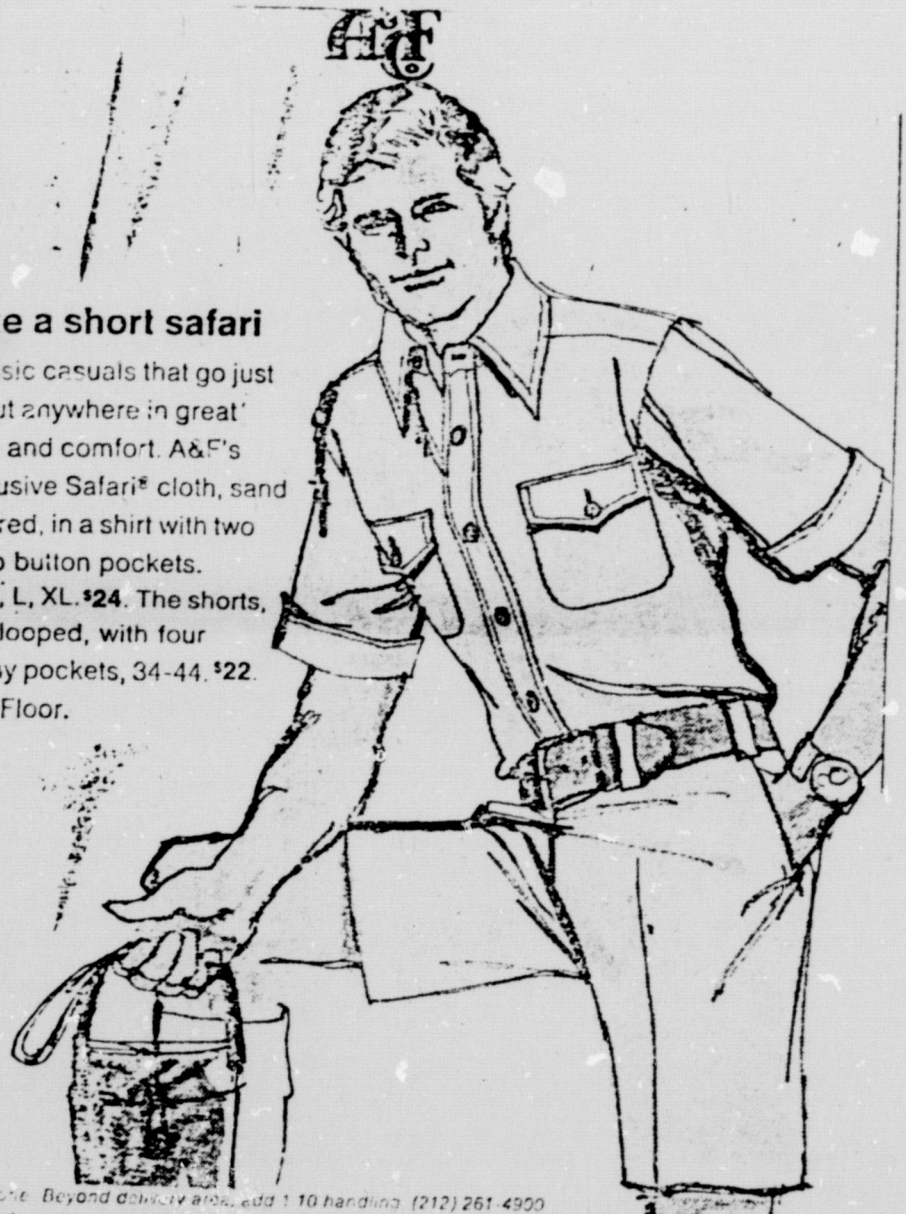
Malcolm Kenneth has created for us what has to be the most magnificent safari suit around. It is, of course, our authentic safari— impeccably crafted in a blend of finest cotton and Dacron® polyester. Then it is lined with 100% acetate. All the appointments are there—the double stitched collar and four pockets. The belted epaulets and cuffs—the leather buttons. Tan. 36-48 regular, 36-42 short, 38-48 long. 135.00. Fifth Floor.

Madison Ave., 45th St., N.Y.
ABERCROMBIE & FITCH (212) 682-3600; Short Hills, N.J.

DX-FF

PE-69

A&F



take a short safari

Classic casuals that go just about anywhere in great style and comfort. A&F's exclusive Safari® cloth, sand colored, in a shirt with two deep button pockets. S, M, L, XL. $24. The shorts, belt-looped, with four roomy pockets, 34-44. $22. Fifth Floor.

city safari

Urbane enough to step down Fifth Avenue—Willis & Geiger's impeccable white Dacron® polyester/cotton safari suit, sizes 6-18. The jacket, $42. The pants, $28. The short-sleeved cotton shirt in white, navy, light blue, pink or yellow, S-M-L. $14. Second Floor.

Mail, phone. Beyond delivery area, add 1.10 handling. (212) 261-4900
Shop easily and quickly with your Abercrombie & Fitch Charge Card, Master Charge or BankAmericard.

ABERCROMBIE & FITCH
Madison Ave., 45th St., N.Y.; Short Hills, N.J.

Mail, phone. Beyond delivery area, add 1.10 handling. (212) 261-4900
Shop easily and quickly with your Abercrombie & Fitch Charge Card, Master Charge or BankAmericard.

ABERCROMBIE & FITCH
Madison Ave., 45th St., N.Y.; Short Hills, N.J.

C. Attractive route to the safari takes the skirt-plus-shirt approach. Safari® cloth frontier skirt from our own workrooms. 8-20. B-58-418. **42.00**. Persian print shirt of polyester/acrylic. 36-40. B-75-4101. **24.00**.

D. Promise her a safari! And give it to her via deftly tailored coordinates of putty-colored Safari® cloth. Bush jacket. 8-20. B-58-306. **45.00**. Frontier pants, also of Safari® cloth. 25-34. B-58-1965. **30.00**.

E. Fr[illegible] shoulder, a canvas and leather bag with adjustable shoulder strap and removable outside pocket that can be worn on a belt. By Lee Stemer. Yellow, natural camel, rusty brown, navy, burgundy and grass. Leather trim. B-66-1311. 2[illegible].00.

complete safari outfit this Christmas . . . .Our authentic bush jacket in animal print cotton."

And, so that members of the public coming to Abercrombie & Fitch can get to the right department, Abercrombie's store directory (DX-JJ) tells them that Safari clothes for ladies will be found on the second floor and that Safari clothes for men will be found on the fifth floor.

Indeed, the descriptive use of the word Safari which appellant has fostered over the years is illustrated by the article entitled "When You're on a Clothes-Hunting Safari" in the magazine section of the New York Post for April 20, 1972 (DX-III), which says:

> "Shooting wild game with your Instamatic in Africa or attending a June wedding in New York — Abercrombie & Fitch can dress you for both.
>
> Abercrombie has of course always been the place for safari togs and other active sportswear. It's the dressy outfits that are the surprise here.
>
> But then Abercrombie is broadening its fashion image. And it just might be because lately safari clothes are drawing a much wider public, thanks to the many bargain tours to Africa sprouting up everywhere. All those medical tours, they tell us for example, have brought in many doctors and their wives, out to vary the professional part of the trip with some wild game shooting — the Kodak kind.

Safari Cloth—Made exclusively for Abercrombie and Fitch to keep people comfortable on safaris. Marvelous summer cloth. 100% sueded cotton. Beautiful feel and comfort. A true sportsman's cloth that makes unique, comfortable weekend and vacation clothing. Only Abercrombie and Fitch has the expertise to design and fashion safari cloth. Available no place else.

D Safari Fishing Vest—detachable creel. Ample pockets for lures. Large rear pocket for rain jacket, lunch, etc. Sand color. Sizes 36-48. 49-14 (1.10) **35.00**

E Safari Trout Helmet—ventilated crown, rain shields, genuine leather sweat band. Sizes 6⅞-7¾. 49-008 (.85) **8.50**

F Safari Bush Jacket for ladies—belted, large pockets, authentic bush jacket. Sand color. Sizes 8-18. 59-306 (1.95) **36.00**

G Safari Frontier Pants for ladies—fly front, snap pockets. Sand color. Waist sizes 25-32 59-1965 (1.95) **25.00**

H Safari Norfolk Jacket—popular belted style—beautifully tailored—slims you. Sand color. Reg., Short, Long. Sizes 36-48. 49-20 (2.20) **50.00**

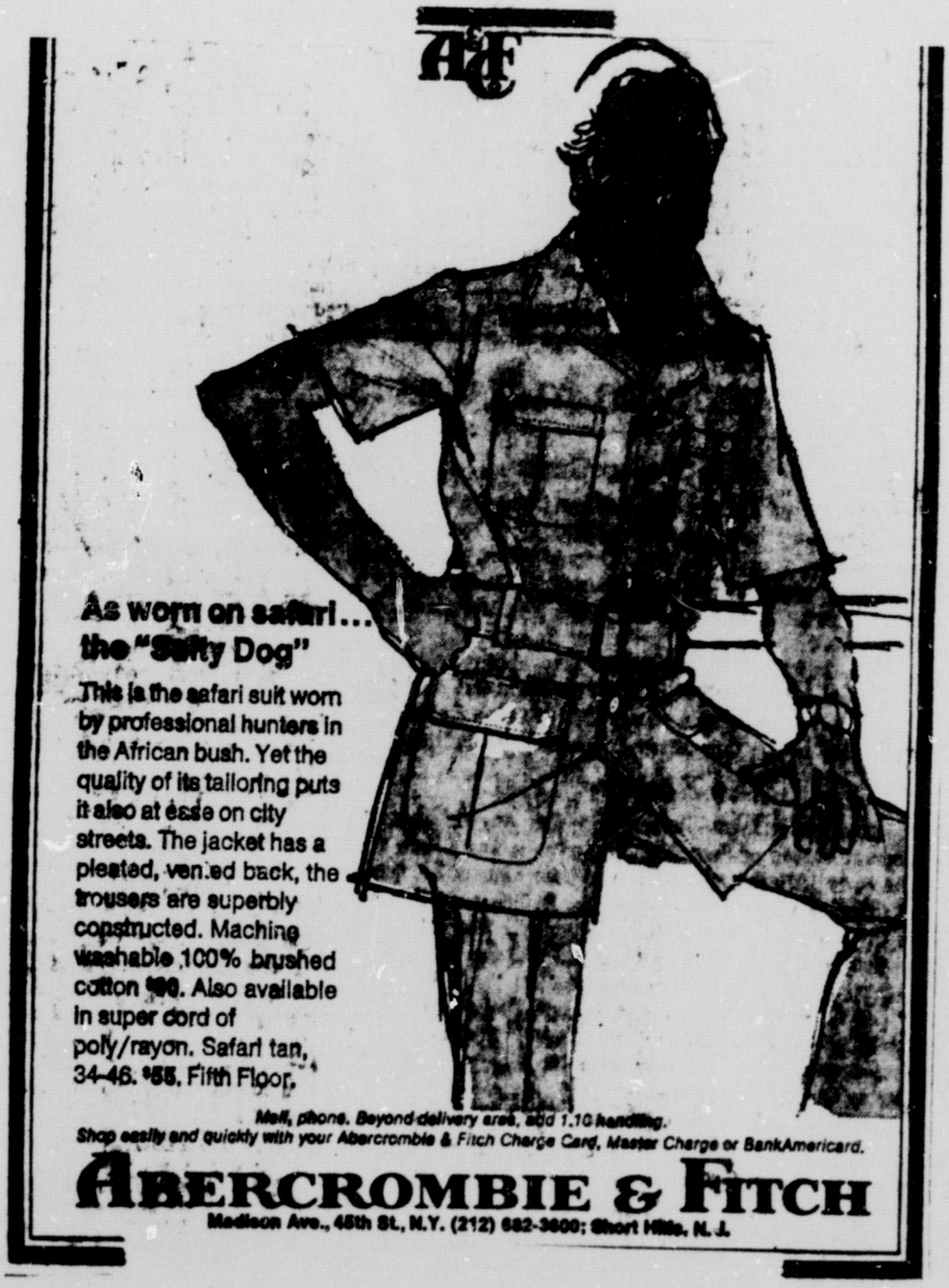
J Safari Slacks For Men—lightweight—beautifully tailored. So very comfortable in summer heat. Sand color only. 49-7070 (2.20) Sizes 30-46 **22.50**

K Safari Shooting Vest—extremely lightweight—nylon mesh ventilated back. Large shell pockets. Sand color. Sizes 36-46. 49-4 (1.10) **20.00**

L Safari Bush Jacket—washable, 4 large pockets in jacket. Belted. Full body. Sizes 36-48—regular and long and short. Sand only. 49-6 (1.65) **37.50**

M Bush shorts are perfect length—same Safari cloth, extremely well cut. Sand color only. Sizes 30-46. 49-6173 (1.65) **17.00**

DX-GG



Exclusive A&F gift safari

A. Give her the complete safari outfit this Christmas—starting with the 100% cotton animal print Aussie style hat. Sunfast, water repellent. S, M, L. 58-30 **15.00.** Our authentic bush jacket in animal print cotton features two bellows pockets, two breast pockets. Sunfast, dripdry. 6-18. 58-300 **40.00.** Fly front ranch pants in textured polyester with two pockets, belt loops. 24-32. 58-1966 **30.00.**

B. Exclusive limited edition lion scarf from France is a most beautiful gift for that special lady. Hand-screened print on pure silk—hand rolled hems. Colorings as shown. 34" square. 65-035 **35.00.**

C. Panda ...the exclusive edition of a superb animal print scarf. Pure hand rolled silk. 65-1800 **18.00.**

D. Decorative leather animals serve as handy footstools, tv-watching seats—or as conversation pieces for den or game room. Crafted in England of rich dark brown leather over sturdy ⅛" steel and wood frames. Filled with Swedish wood shavings. Three sizes. Elephant, 96-[illegible]. Donkey, 96-[illegible]. Rhino, 96-[illegible]. Small, [illegible]. Medium, [illegible]. Large, [illegible].

E. [illegible] in suede from Spain was originally designed as [illegible] and small leather goods. Terrific for holding [illegible]. Has small zip pocket inside. Padded strap. Shades [illegible].

B

E

> Along with their very first safari outfits, these women — to mention only one group of new fans — still need all the usual casual but versatile day and dressy clothes.
>
> Versatility as in Abercrombie's shortsleeved safari suit in an exclusive cotton that shrugs off dirt, dust and water. It's a great town and travel outfit for summer, now that the bush jacket is in the best high fashion designer collections."

A statement by Henry C. Geis, plaintiff's vice president and treasurer and its sole witness at the trial, in an article entitled *"The Great Safari Suit Flap,"* published in the New York Times for September 15, 1974, leaves little doubt as to the nature of plaintiff's use of "safari." Mr. Geis said:

> "We carry a line of safari suits, hats, boots, cloth and picnic grills says Mr. Geis, 'and anyone advertising safari suits' or 'safari *anything*' is guilty of copyright infringement. It's permissible to say that a suit is suitable for a safari, but only we can advertise it as a 'safari suit'."

It is thus evident that Abercrombie's use of the word Safari is intended to convey to the purchaser, and does convey, the character and nature of the goods which are sold as Safari merchandise. In plaintiff's own language "the only thing that people thought of when they encountered the word "safari" was the big game hunt, led by an expert guide, under a broiling African sun" (DX-KK). The Salty Dog suit advertised by

Here's where you'll find what-at

ABERCROMBIE & FITCH

When You're on a Clothes-Hunting Safari

By RUTH PRESTON

UPTOWN

SHOOTING wild game with your Instamatic in Africa or attending a June wedding in New York—Abercrombie & Fitch can dress you for both.

Abercrombie has of course always been the place for safari togs and other active-sportswear. It's the dressy outfits that are the surprise here.

But then Abercrombie is broadening its fashion image. And it just might be because lately safari clothes are drawing a much wider public, thanks to the many bargain tours to Africa sprouting up everywhere. All those medical tours, they tell us for example, have brought in many doctors and their wives, out to vary the professional part of the trip with some wild game shooting—the Kodak kind.

Along with their very first safari outfits, these women—to mention only one group of new fans—still need all the usual casual but versatile day and dressy clothes.

Versatility as in Abercrombie's short-sleeved safari suit in an exclusive cotton that shrugs off dirt, dust and water. It's a great town and travel outfit for summer, now that the bush jacket is in the best high fashion designer collections.

Pros appreciate the details in Abercrombie's business-like sports coordinates (many made in the store's own workrooms) in tan, brown or dark green whipcord, forestry cloth and that resist-everything-cotton: the fishing jackets with cigaret pocket sleeve, creel strap and back pocket big enough to hold the catch; the cotton poplin pants with canvas fronts for ploughing through briars and quilted linings for winter; the hunting jackets with action backs and blood-proof pockets . . .

Just as tennis and ski clothes have beeen found practical for more general wear, so individualists are sure to discover reasons for patronizing this special de-

Post Photos by Terence McCarten

You could collect an all-purpose wardrobe at Abercrombie & Fitch, now that the sportswear specialists have added dressy clothes. Like the flowered cotton dress-and-jacket outfit at left above. And the long white duck skirt and jersey turtleneck at center. A & F's signature safari suit at right would look at home in New York this sporty season. Below, white ducks with plaid cotton shirt, stylish in red-white-blue.

$98 for the twosome, they include the bare look, as in a jersey halter with skirt in embroidered multicolor striped cotton, and the covered-up, in a black silk organza shirt paired with skirt of black and white dotted and embroidered cotton.

Shifts at $20 and $38 (and, like everything here, many go up to size 18) are enormously varied in style. So are Izod's classic knit golf dresses ($33 to $40)—that many well-dressed women have made their all-purpose daytime uniform. Even the classic Aquascutum rain-or-shine coat is now available here in snappy novelty styles. They're $130.

> Along with their very first safari outfits, these women — to mention only one group of new fans — still need all the usual casual but versatile day and dressy clothes.
>
> Versatility as in Abercrombie's shortsleeved safari suit in an exclusive cotton that shrugs off dirt, dust and water. It's a great town and travel outfit for summer, now that the bush jacket is in the best high fashion designer collections."

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plaintiff was "As worn on safari" and "is the safari suit worn by professional hunters in the African bush. Yet the quality of its tailoring put it at ease also on city streets" (DX-GG). And, in its advertising of Safari Week at Abercrombie & Fitch (DX-LL) plaintiff took pains to advise the public "We put the mark on 'Safari' because we own it. We outfitted such noted Safari-bound as Theodore Roosevelt and Ernest Hemingway." Far from being suggestive, these uses were descriptive and explicit.

The cases which plaintiff cites as authority for its claim of an exception to the rule that a descriptive word may not receive trademark protection in the absence of established secondary meaning are as inapplicable as its factual claims.

Thus, in this Court's decision in *Venetianaire Corp. of America v. A & P Import Co.*, 429 F.2d 1079 (2d Cir. 1970), what was involved was the section of the Lanham Act which prohibited the use in commerce of any reproduction, counterfeit, copy or colorable imitation of a registered mark where such use is likely to cause confusion, to cause mistake, or to deceive (15 U.S.C. 1114). This Court affirmed the District Court's finding that there was such copying. In this case, of course, there has never been any claim or suggestion of copying or of confusion.

In *W.E. Bassett Company v. Revlon, Inc.*, 435 F.2d 656 (2d Cir. 1970), this Court found that the mark involved there was a descriptive mark, and that it had established a secondary meaning. And in *Blisscraft of Hollywood v. United Plastics Company*, 294 F.2d 694 (2d Cir. 1961), this Court's decision was based upon the copying aspect of the case, this Court saying at page 702:

> "What defendant attempted to do was to share in the good will the plaintiff had built up for itself through the use of the 'Poly Pitcher' designation. This conclusion is fortified by the close visual resemblance in color, scheme and design which the label chosen by the defendant bears to that which the plaintiff had been using for the preceding three years. Defendant's choice cannot be deemed to have been coincidental. Taking all these factors together, it is clear that the defendant's purpose was to cause prospective purchasers to mistake its own label for that of the plaintiff, and so enhance its own sales."

In that case, the Court pointed out that at the time that plaintiff first began to use the "Poly Pitcher" labels there was nothing to show what the public understood by this, noting that, unlike the situation here, there were not even dictionary references, general or scientific, indicating that poly meant polyethylene. Here, when plaintiff in 1937 applied for a registration of the mark "Safari" (PX-4), the Patent Office Examiner initially refused registration, saying:

> "Registration under the Act of February 20, 1905 is refused on the ground that the mark presented on the drawing is descriptive of the goods in that it signifies that they are intended for use in hunting expeditions. 'Safari' is defined in Webster's Dictionary (footnotes) as: 'A Journey; esp., a hunting expedition'."

Plaintiff's claim in its brief that its use of "Safari" was fanciful rather than descriptive appears to be based to a large degree upon Judge Ryan's comment at the trial when plaintiff offered a pair of its safari shoes (PX-9) in evidence, and his further comment in his decision. When such shoes were offered, Judge Ryan said:

> "THE COURT: What are they, a pair of Keds?" (A87).

In his decision, he said:

> "It matters not that the hat or shoe may not be used actually on safari by the purchaser or that it is not fit for a safari. In fact, plaintiff's 'safari' shoes and hats were admittedly not fit for a safari; those shoes looked like sneakers and the hat was a fishing hat" (A63-64).

It is perhaps the fact that these articles were sold as safari shoes and safari hats to Abercrombie customers that gives meaning to the statement of Lucille Schulberg Warner in her article "How To Take A Safari Without Being Stanley or Livingston," published in the travel section of the New York Times for Sunday, December 9, 1973, pp. 1 and 7, that

> "In fact, on our trip, we would have felt fairly foolish in Abercrombie & Fitch's safari costume."

and to the statement of Alex Lewyt, quoted in Time Magazine's article on safaris, published in its issue of February 16, 1970, at page 68 (DX-III) that

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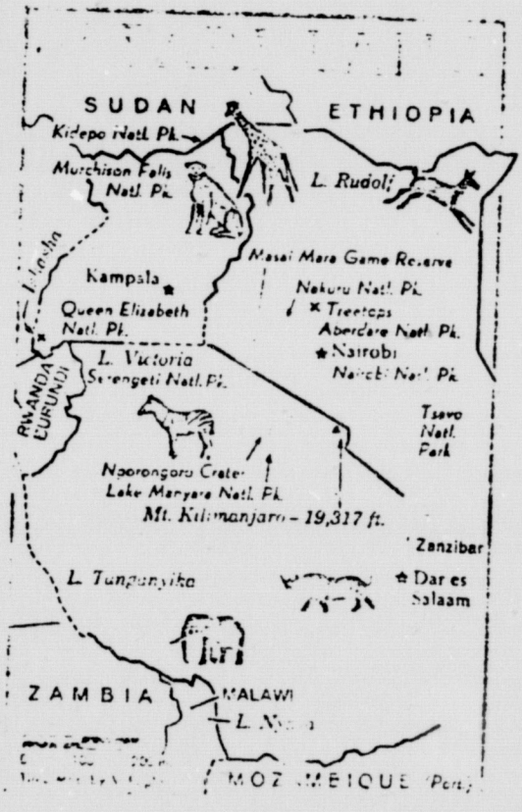
MODERN LIVING

Travel: Camera with Cross Hairs

IN East Africa, that magical land of the Masai, the Mau Mau and the Macombers, February is the middle of summer—and summer is safari season. To many Americans, the word safari (Swahili for journey) still conjures up a vision of Stewart Granger beating bravely through the bush, trailed by the wealthy, red-faced "Bwana Mkubwa" (Big Boss), his bored, flirtatious wife and a long line of naked natives with rifles, cook pots and bathtubs balanced on their heads. A more accurate vision is apt to be somewhat less theatrical. Outside Nairobi's new circular Hilton Hotel (the "Tiltin' Hilton"), a gaggle of middle-aged, middle-class Americans clamber into a zebra-striped minibus. Whisked off to a government-operated park, they spend the day shooting everything that moves—with cameras. On the way back, they stop to shop for souvenirs: Masai warriors' spears (forged in Birmingham, England) and "elephant hair" bracelets (actually made of plastic) that are supposed to guard the wearer against attack by a frenzied pachyderm. That is safari, 1970 style, the newest travel mania.



Hunters of the Ernest Hemingway persuasion, of course, can still arrange an old-fashioned "Big Five" (lion, leopard, elephant, rhinoceros, Cape buffalo) trophy hunt, provided they have the patience and the price. East Africa's top white hunters are so busy that they are already taking advance reservations for 1973. Most shooting safaris last a minimum of 21 days, and they are exorbitantly expensive. In Kenya, the daily charge per person for four clients with two professional hunters is $422. That fee does not include clothing, game licenses ($300 for a single rhino, plus an extra $600 if the specimen shot turns out to be a female), rental of weapons, ammunition, National Parks entry fees, liquor, tips to the African gunbearers, cooks, guides and skinners, or taxidermy charges. Total bill for a 21-day hunt: about $12,000.

Spear-Carrying Bushmen. Small wonder that the camera safari has become so popular. A number of U.S. tour firms are now packaging and promoting all-expense camera safaris, and about 20,000 American tourists will go on safari this year in the East African nations of Kenya, Tanzania and Uganda, staying an average of 21 days and spending $650 (exclusive of air fare) on the trip. Not only are the economics attractive, the experience is mind-boggling —because everything in East Africa seems to be superlative.

Residents of the area boast that the original Garden of Eden was located there, and few visitors would dispute the claim. There is the shockingly clear blue sky, the bright orange moon, the mauve mountains and burnt-umber plains—to say nothing of the teeming wildlife. "The more U.S. cities get clogged up and polluted, the more people want to lose themselves in wilderness —in something that makes sense," says Chris Pollet, a former professional hunter who works as a tour consultant for Winchester Adventures. "A camera safari is the best therapy for city dwellers" —and for single ladies from Sacramento. They sit on the hotel veranda, sipping martinis while feeding canapés to begging baboons and spraying each other with Bug-Off. Alex Lewyt, of the vacuum cleaner family, is about to take his fourth camera safari. "The minute you land in Nairobi, all your senses undergo a change," he says. "It's what a low-pressure LSD trip must be like. It's fantastic to watch the Abercrombie & Fitch types rubbing shoulders with spear-carrying bushmen."

A typical camera safari starts in the gleaming, modern metropolis of Nairobi (pop. 477,600). In the Nairobi National Park, just seven miles from the center of town, cheetahs blithely hitch rides on the roofs of passing cars and lions stare dully at the screen of a neighboring drive-in movie. Next stop might be Aberdare National Park and the Treetops Hotel, 65 miles north of Nairobi. A sort of "hide," or hunting blind, with beds, Treetops is built on stilts and overlooks a water hole and a salt lick —gathering places each sunset for elephants, black rhinos, giant forest hogs and several species of antelope, including the rare and elusive bongo.

Rapacious Fish. Roughly the size of California and Oklahoma combined, Kenya boasts a dozen other prime hunting areas for buffs with cross hairs on their cameras. At Tsavo National Park, famed for its 20,000 elephants, overnight visitors sleep (at $21 a night) in a tent camp. On the Masai Mara Game Reserve, proud Masai tribesmen—bodies covered with red ocher clay, scarlet cloaks knotted over one shoulder—compete with golden-maned lions for photographers' attention. Although East African natives often refuse at first to pose for cameras—on the ground that their souls may become trapped in the little black box—the barest flash of green turns superstition into cooperation.

At Lake Rudolf, on the Ethiopian border, the big attraction is fishing: its waters are home to the Nile perch, a rapacious—and delicious—fish that can weigh more than 200 lbs. and has been known to attack a hook baited with nothing more attractive than an old tennis shoe. The lake is also inhabited by more than 150 separate species of wildfowl.

The compleat East African camera safari must include side trips to Kenya's neighbors, Tanzania and Uganda. For sheer profusion of wildlife, no place in the world can match Tanzania's Serengeti National Park, with its 350,000 wildebeests and 150,000 zebras. Ngorongoro Crater, 32 miles to the southeast, is an enormous extinct volcanic crater (10 miles across, 2,000 ft. deep), and supports large numbers of wild canines. In Uganda, there are such natural attractions as Murchison Falls National Park, famed for its cataract and crocodiles, and the pygmies of the Ituri Forest.

Mauled Hunter. New low-jet airline fares ($754 round trip between Nairobi and New York) and East Africa's deliberately high license fees and strict hunting limits have combined to make the camera safari an attractive, middle-class substitute for the aristocratic trophy hunt. "People coming to Africa with just cameras don't want trophies on their walls," says Patrick Hemingway, 40, the novelist's son and a onetime professional hunter turned ecologist. "On photo safaris people can take pictures of the same animal over and over again, while they can only hunt and kill it once." Other white hunters seem to be coming around to Hemingway's point of view. In a Dar es Salaam waterfront hotel last week, Don Rundle, 28, exhibited a badly scarred claw and right arm—mauled by a leopard that had been wounded by an inept hunting client. "I'm all for camera safaris," he said. "People shoot straighter with a camera than with a gun."

> "It's what a low-pressure LSD trip must be like. It's fantastic to watch the Abercrombie & Fitch types rubbing shoulders with spear-carrying bushmen."

Point IV

The District Court correctly found that plaintiff's use of the Safari mark has not been a proper one, that it has accordingly lost such trademark rights in it as it ever had, and properly directed that its registration be cancelled.

In his decision Judge Ryan correctly pointed out that under the statute — 15 U.S.C. 1052(e) and (f) — a descriptive name may be protected only if it has through use become identified with plaintiff as its producer, rather than its products (A65).

In addition, the statute — 15 U.S.C. 1064(c) — provides that a mark may be cancelled if at any time it becomes the common descriptive name of an article or substance or has been abandoned. The statute further, in 15 U.S.C. 1127, provides that a mark shall be deemed abandoned

> "When any course of conduct of the registrant, including acts of omission as well as commission, causes the mark to lose its significance as an indication of origin."

The statute also provides — 15 U.S.C. 1064(e) that a mark may be cancelled on the ground that the registrant does not control, or is not able legitimately to exercise control over the use of such mark.

The trial Court found that

> "Moreover, the evidence showed that the word 'safari' in connection with wearing apparel is widely used by the general public and the people in the trade.
>
> There was evidence that at least fifteen prominent clothing stores had used the word to describe all sorts of wearing apparel and it is significant that plaintiff itself had used the word in its advertising catalogues in a purely descriptive sense to describe items clearly not covered by its registration, when it designated a Christmas shopping trip as a 'Christmas Gift Safari' and referred to 'The Supreme Safari' and to gifts as a 'Gift Safari.'
>
> Although there was evidence the plaintiff had attempted to police some of these uses by people in the trade, there continued to be widespread use of the word and plaintiff was unable to control it. Admitted ignorance on the part of these users of plaintiff's claimed trademark is eloquent proof of the weakness of the mark and established the complete absence of any secondary meaning in it" (A64).

These findings were overwhelmingly supported by the record (PX-39, PX-40, DX-A, DX-B, DX-C, DX-D, DX-E, DX-F, DX-G, DX-H, DX-I, DX-J, DX-K, DX-L, DX-N, DX-

O, DX-P, DX-Q, DX-R, DX-S, DX-S1, DX-T, DX-U, DX-V, DX-W, DX-X, DX-Y, DX-Z, DX-AA, DX-CC, DX-DD, DX-EE, DX-FF, DX-GG, DX-HH, DX-JJ, DX-KK, DX-LL, DX-NN, DX-OO, DX-PP, DX-QQ, DX-SS, DX-III, PX-33, PX-34, PX-35).

The Court further said:

> "After hearing the evidence, I go further and do now find that the mark is invalid because it is merely descriptive and does not serve to distinguish plaintiff's goods as listed in the registration from anyone else's. *Bassett Co. v. Revlon, Inc.*, 354 F.2d 868 (C.A. 2 1966); *Feathercombs v. Solo Products Co.*, 306 F.2d 495 (C.A. 2 1962); *Safeway Stores v. Safeway Properties, Inc.*, 307 F.2d 495 (C.A. 2 1962). Besides widespread use by plaintiff on other products and in other senses to describe the source or type of its goods and services, and its inability to control its use by others, have caused it to lose any identification it might have had originally with plaintiff's goods (although there was no proof of this) and a total loss of rights in it (15 U.S.C. 1064(c)(e), 1127; *Du Pont Cellophane Co. v. Waxed Products Co.*, 85 F.2d 75 (C.A. 2 1936).)
>
> Under the statute, a descriptive name may be protected only if it has through use become identified with plaintiff as its producer, rather than with its products. 15 U.S.C. 1052(e)(f).

There has been absolutely no evidence of any confusion, any palming off or any injury to the public or to plaintiff from defendant's use of the name 'safari' in any of its uses. The evidence of a widespread use of the word by the public and the present competition belies identification with any particular person. The trial proof showed that plaintiff's competitors, far from attempting to benefit from plaintiff's name and reputation, were genuinely surprised that plaintiff had registered the name and had claimed trademark significance.

No claim of copying by defendant is made. On the contrary, defendant has its own mark 'Hunting World, Inc.' and asserts its own fame in the market. Moreover, the hats and shoes produced by plaintiff differed significantly from that produced by defendant. In the absence of any confusion, there is no legal right in plaintiff to attempt to appropriate a mark. *Venetianaire Corp. of America v. A & P Import Co.*, 429 F.2d 1079; *King-Seeley Thermos Co. v. Aladdin Industries, Inc.*, 321 F.2d 577 (C.A. 2 1963).

I find and conclude that the mark is invalid, that it belongs in the public domain, and direct that its registration be cancelled. 15 U.S.C. 1119; *Feathercombs v. Solo, supra*" (A65-66).

In *DuPont Cellophane Co. v. Waxed Products Co.*, 85 F.2d 75 (2d Cir. 1936), *cert. den.*, 299 U.S. 601 the use of the mark by

the registrant in a generic and descriptive sense resulted in the trademark protection being lost and the mark being available to all. As has been pointed out, plaintiff here has made such generic use, and the Court properly found that this resulted in a loss of its trademark rights.

And, as the Court pointed out, plaintiff permitted the use of the word safari by others in relation to these same articles, and manifested an inability to control the use of the term by others. Thus, on May 22, 1970, Saks Fifth Avenue advertised "Our City Safari Hat" in the New York Times (DX-C). Plaintiff took no corrective action in regard to this. Again, on September 23, 1972, Paul Stuart, a competitor of plaintiff whose shop is across the street from plaintiff, advertised "Our Authentic Safari Jacket" in the New York Times (DX-D). Plaintiff took no steps to correct this. Many others have likewise used safari in regard to such items, and still continue to do so without abatement (DX-A, DX-B, DX-E, DX-F, DX-G, DX-H, DX-I, DX-J, DX-M, DX-N, DX-O, DX-P, DX-Q, DX-S, DX-T, DX-U, DX-V, DX-AA, DX-CC, DX-DD).

Point V

The District Court properly held that defendant's use of Safari has been a fair use in good faith to describe its goods and services and their geographical origin.

In his decision on defendant's motion for summary judgment, Judge Lasker commented as follows with respect to the defendant:

> "Defendant is a New York corporation which began its business in New York City in 1965 as an outgrowth of Lee Expeditions, Ltd., an organizer of safaris and expeditions in Africa, Asia and India. Lee Expeditions continues to seek products in those areas for distribution through Hunting World. All of Hunting World's merchandise is related to safaris and hunting, either for use in such activity, as, for example, in pictures and art work of wildlife and hunting, hunt trophies, or exotic products such as elephant skin clothing products" (A27).

Since 1959 Lee Expeditions, Ltd. has arranged and conducted safaris for persons who wish to go on safaris (A251). First Lee Expeditions, Ltd., and then defendant, made arrangements to outfit safari clients with the kind of clothing and equipment that they needed for safaris, and imported such clothing and equipment from African manufacturers into the United States (A251).

Defendant uses the term "Safari Shoes From Safariland" and "Safari Chukka" to refer to shoes and boots manufactured in Africa and used on African safaris, and imported by it into the United States for use in its safari outfitting business (A268-269, 271-272, 313-319, DX-FFF, DX-KKK).

Defendant uses the term "The White Hunter—Hats For Safari" to refer to hats made in Africa, used on African safaris, and imported by it into the United States as part of its safari outfitting business (A262-267, 288-289, DX-GGG).

Defendant also merchandises a second hat called "Minisafari" which is identical with its Safari hat, except that the brim, instead of being a three and a half inch brim, is cut down to two inches. The Minisafari is also manufactured in Africa by Dorian, and imported into the United States (A266-267, 342, PX-77, DX-NNN).

Defendant also uses the term "Safari Clothes From Safari Country" in connection with the sale of Kalahari clothing imported from Africa (A251, 291-294, 336-337, DX-OOO).

Defendant formerly sold "Hippo Safari" shoes, identical with the original safari shoe except that it was fashioned out of hippopotamus leather (A280), and the "Camel Safari Chukka," the identical shoe made of camel leather (A281). Defendant discontinued promoting and selling such items because they did not sell well (A280-281).

Defendant also uses the word "Safariland" to designate a portion of its store, and also as a title for its "Safariland Newsletters" which Lee Expeditions, Ltd. first began publishing in 1959 (A255-258, DX-VV). Such newsletters contain news bulletins as to safari activity in Africa and elsewhere, hunting license schedules, etc. At page 68 of its issue for February 16, 1970, Time Magazine published a map (DX-III) entitled "SAFARI LAND" covering all of the areas of Africa inviting safari activity.

Judge Ryan found all of these uses of safari by the defendant to be descriptive and proper, saying:

> "The use by defendant of such expressions as 'minisafari' to designate a small model of an actual hat; 'Safariland' to designate its trade newsletter; 'Camel safari,' 'Hippo safari,' 'Safari chukka', to describe its shoes and boots; is a purely descriptive use to apprise the public of the type of product by referring to its origin and use. It matters not that the hat or shoe may not be used actually on safari by the purchaser or that it is not fit for a safari. In fact, plaintiff's 'Safari' shoes and hats admittedly were not fit for a safari; the shoes looked like sneakers and the hat was a fishing hat.
>
> It is to be noted that defendant's hats and shoes were made in Africa and that the boots were expressly made for safari expeditions.
>
> Moreover, the evidence showed that the word 'safari' in connection with wearing apparel is widely used by the general public and the people in the trade" (A63-64).

Plaintiff has expressed its disagreement with such findings and conclusions of the District Court. The only authority which invokes to support such disagreement is a quotation, taken out of context, from this Court's decision in *Venetianaire, supra.* It quotes the statement from that opinion that the defendant there infringed the trademark of the plaintiff, even though "hygienic" was capable of descriptive, and therefore infringing use. But it omitted the statement in the following paragraph that

> ". . . the record makes it plain that defendant, knowing of plaintiff's packaging, adopted a trademark and wrapper almost identical to plaintiff's. That fact eliminates any doubt that that defendant was not entitled to claim fair use of a descriptive term as a defense to infringement of plaintiff's trademark."

The comments of Mr. Justice Holmes in *Prestonettes v. Coty, Inc.*, 264 U.S. 359, 368 with regard to trademarks are applicable here. he said:

> "Then, what new rights does the trademark confer? It does not confer a right to prohibit the use of the word or words. It is not a copyright. . . .A trademark only gives the right to prohibit the use of it so far as to protect the owner's good will as against the sale of another's product as his. . . . When the mark is used in a way that does not deceive the public we see no such sanctity in the word as to prevent its being used to tell the truth."

Plaintiff in its brief asks the rhetorical question "What is a Minisafari?," and then goes on to aver that a use involving "Mini" is not automatically a descriptive use. The question put by plaintiff has been answered by a number of judges.

In his opinion on defendant's motion for summary judgment, Judge Lasker said:

> "The second hat alleged to infringe is defendant's so-called 'Mini-safari' hat, a hat in the same style as the genuine safari hat, with the brim trimmed back. The use of 'safari' here as part of a novel coined expression is not an infringement of any possible trademark of the plaintiff for several reasons: (1) it is fresh and original in its creation; (2) it is literally descriptive of the product to which it attaches, a little safari hat; (3) it is a product sufficiently different from plaintiff's swordfisherman's cap to avoid the possibility of confusion; (4) in any event, it is sufficiently distinct from the use of 'safari' alone not to connote the same origin" (A36).

In his decision after trial, Judge Ryan said:

> "I agree with Judge Lasker that the name 'mini-safari' is literally descriptive of a small safari hat and, as such, would not be entitled to registration" (A67).

And, in a similar situation, *In re Agnew Enterprises, Inc.*, 171 U.S.P.Q. 127 (decided June 25, 1971), the Patent Office Trademark Trial and Appeal Board said:

> "'Mini-Lite' is merely descriptive as applied to miniature sized lighting fixtures. . . .Plaintiff concedes that 'Mini' does have the dictionary meaning of miniature. Plaintiff's own literature describes 'Mini-Lite' fixtures as being

> 'miniaturized lighting fixtures.' In our opinion, the term 'Mini-Lite' describes such a fixture and is merely descriptive of plaintiff's goods within the meaning of Section 2(e)(1) of the Act of 1946."

Finally, plaintiff attacks defendant's use of its safari advertising on the ground that its advertising material uses bold type and quotation marks. Plaintiff claims that this is done to attract public attention and "is the indicia of trademark use." Plaintiff has overlooked the fact that the use of bold type and quotation marks is part of the style which characterizes all of defendant's advertising and catalogues over the years (PX-52, PX-53, PX-57, PX-59, PX-65, PX-73, PX-74, PX-75, PX-76). Such characteristics compatible with defendant's normal advertising material in its advertisements and catalogues, is not indicia of trademark use. There is no merit to such argument.

CONCLUSIÓN

The decision of the District Court was correct and should be affirmed in all respects.

Respectfully submitted,

MOSS, WELS & MARCUS
Attorneys for Defendant-Appellee

Richard H. Wels
Of Counsel

A 202 Affidavit of Personal Service of Papers — LUTZ APPELLATE PRINTERS, INC.

COURT OF APPEALS OF THE UNITED STATES
for the Second Circuit

ABERCROMBIE & FITCH COMPANY,

Plaintiff-Appellant,

- against -

HUNTING WORLD INC.,

Defendant-Appellee.

Index No.

Affidavit of Personal Service

STATE OF NEW YORK, COUNTY OF New York *ss.:*

I, James Steele, *being duly sworn, depose and say that deponent is not a party to the action, is over 18 years of age and resides at* 250 West 146th, Street, New York, New York
That on the 14th *day of* May *1975 at* 60 E. 42d St, N.Y., N.Y.

deponent served the annexed Respondents Brief *upon*

Sandoe Hopgood & Calimafde

the Attorneys *in this action by delivering* 2 *true copy* es *thereof to said individual personally. Deponent knew the person so served to be the person mentioned and described in said papers as the* Attorney(s) *herein,*

Sworn to before me, this 14th
day of May *19* 75

Robert T. Brin

James Steele
JAMES STEELE

ROBERT T. BRIN
NOTARY PUBLIC, State of New York
No. 31-0418950
Qualified in New York County
Commission Expires March 30, 1977